UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte MATTHEW J. BURDICK and GREGOIRE JAUNIN

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Appeal 2008-004298
Application 10/699,629
Technology Center 2100

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Decided: September 24, 2009

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Before ALLEN R MACDONALD, ST. JOHN COURTENAY III, and
DEBRA K. STEPHENS, *Administrative Patent Judges.*

STEPHENS, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1-47. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

Introduction

According to Appellants, the invention is a system and method for validating a configuration setting of one application for use with a second application (Abstract).

Exemplary Claim(s)

Claim 1 is an exemplary claim and is reproduced below:

1.   A method comprising validating a configuration setting of a first application for use with a second application, wherein:
    the configuration setting including a first field and a first description of a first condition for the first field;
    the second application is composed of computer instructions, the computer instructions having an attribute, the attribute providing a second description of a second condition for a second field; and
    the validating includes:
        if the first field corresponds to the second field, then comparing the first description of the first condition with the second description of the second condition to determine whether the first condition is met by the second condition; and
        if met, then determining that the configuration setting is valid for use with the second application.

36.   A content server comprising:
    a broadcast transmitter configured to provide media content to a client in response to a request from the client;
    a processor; and
    memory configured to maintain:

a first application that when executed provides media content for broadcast by the broadcast transmitter, wherein the application is composed of computer instructions, the computer instructions have attributes, and each said attribute provides a description of a condition for a field; and

a documenter that is executable on the processor to generate a configuration file having a configuration setting of the first application, wherein the configuration setting includes the field and the description of the condition for the field.

Prior Art

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Joory	2002/0026436 A1	Feb. 28, 2002
Mullen	2004/0243997 A1	Dec. 2, 2004

Rejections

The Examiner rejected claims 1, 5-9, 13-14, 18-19, 23-24, 28-30, 32-34, 36, and 40-41 under 35 U.S.C. § 102(e) as being anticipated by Mullen.[1]

The Examiner rejected claims 2-4, 10-12, 15-17, 20-22, 25-27, 31, 35, 37-39, and 42-47 under 35 U.S.C. § 103(a) as being unpatentable over Mullen and Joory.

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1 Although the headings in the Appeal Brief, the Answer, and the Reply Brief omit claim 5 from the rejection under 35 U.S.C. § 102(e) as being anticipated by Mullen, all of the Appeal Brief, the Answer, and the Reply Brief address claim 5 in the rejection under 35 U.S.C. § 102(e) as being anticipated by Mullen. We consider claim 5 before us on appeal because the Examiner has clearly set forth a rejection for claim 5 on page 4 of the Answer.

GROUPING OF CLAIMS

(1) Appellants present analogous arguments for claims 1, 9, 14, 19, 24, 28, 32, and 40 (App. Br. 22-33). Therefore, we will treat claims 9, 14, 19, 24, 28, 32, and 40 as standing or falling together with representative claim 1.

(2) Appellants argue claim 36 based on separate arguments (App. Br. 32).

(3) Appellants argue claim 37 separately (App. Br. 37).

(4) Appellants argue claims 38 and 39 as a group on the basis of claim 36 from which these claims depend (App. Br. 37). We will, therefore, treat claims 38 and 39 as standing or falling with claim 36.

We accept Appellants' grouping of the claims. See 37 C.F.R. § 41.37(c)(1)(vii) ("Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately.").

ISSUES

Issue 1: 35 U.S.C. § 102(e): claims 1, 5-9, 13-14, 18-19, 23-24, 28-30, 32-34, and 40-41 and 35 U.S.C. § 103(a): claim 45

With respect to all claims on appeal, Appellants argue their invention is not anticipated by Mullen (App. Br. 22). Appellants argue Mullen discloses determining and copy functionality, not a comparison or validation function (App. Br. 23-38).

In response, the Examiner maintains Mullen describes a condition
(file or parameter name) for the field (configuration setting entry) (Ans. 21-
22, §(10)A. I.). The Examiner further contends "a comparison of these
conditions can be inferred" from Mullen's statement that 'if the
configuration settings to copy comprise parameters in a data structure, such
as a registry file or other file, then the . . . ' (see paragraph 0029, lines 17-
23)." (Ans. 22, §(10)A.I.). The Examiner further contends Mullen discloses
a system installation package that validates configuration settings (Ans. 23,
§(10)A.V.).

Issue 1: Have Appellants met the burden of showing the Examiner
erred in finding Mullen discloses comparing or validating descriptions or
configuration settings?

<center>FINDINGS OF FACT (FF)</center>

<center>*Mullen Reference*</center>

(1)   Mullen describes a method, system, and program for installing
program components on a computer (Abstract). The installation program 52
in the system installation package 50 installs the operating system 110 and
application(s) 112 in the system installation package 50 (pg. 2, [0024]). The
installation program 52 copies operating system configuration settings from
the preexisting OS configuration settings 106 and the preexisting application
configuration settings 110 to the installed OS configuration settings 126 and
installed application configuration settings 130, so that the configuration
settings used in the preexisting configuration are carried over to the
components being installed by the system installation package 50 (*id.*).

<center>5</center>

(2)   The configuration setting entry 80 may indicate a directory location and file or parameter name for the operating system or application program configurations settings 84a, 84b . . . 84n for the preexisting installation to copy and the target directory location of where to write the copied preexisting configuration settings 106, 110 (pr. 3, [0029]). The configuration settings 84a, 84b . . . 84n may indicate the source of the configuration settings to copy as relative to the root of the preexisting directory locations 102 and the target location to write the configuration settings as relative to the root of the directory locations 122 for the new installation (*id.*). Alternatively, the configuration settings 84a, 84b . . . 84n may indicate the source and target locations for the configuration settings to copy as absolute file directory locations (*id.*).

PRINCIPLES OF LAW

Anticipation

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. *RCA Corp. v. App. Dig. Data Sys., Inc.*, 730 F.2d 1440, 1444 (Fed. Cir. 1984); *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554 (Fed. Cir. 1983).

"Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations and internal quotation marks omitted).

ANALYSIS

We find the Examiner has not shown that the claim limitations of validating and comparing are expressly found in the reference. The Examiner seems to be implying the claim limitations are inherent: "a comparison of these conditions can be *inferred* from the statement." (Ans. 22, §10. A. I., emphasis added); however, inherency may not be established by probabilities or possibilities. Moreover, an inference or suggestion is only relevant in the context of § 103. Therefore, although comparing or validating may be a probability or possibility, we find the Examiner has not fully developed the record to establish that the system described in Mullen inherently (i.e., necessarily) discloses comparing or validating as recited in claims 1, 9, 14, 19, 24, 28, 32, and 40.

Claim 45 was rejected under 35 U.S.C. § 103 for obviousness. The Examiner relies upon Mullen's teaching of copying and writing configuration settings as inherently teaching comparing and validating. We find the Examiner has not set forth enough evidence to persuade us comparing and validating are inherent to the process taught by Mullen or are suggested to one of ordinary skill in the art. Instead we find bridging this gap would require speculation on our part. Therefore, we find Mullen does not teach or suggest comparing the first description of the first condition with the second description of the second condition as recited in claim 45.

CONCLUSION

We find Appellants have met the burden of showing the Examiner erred in finding Mullen discloses validating that includes comparing the first description of the first condition with the second description of the second condition to determine whether the first condition is met by the second

condition or validating whether a condition is met by a second application. Accordingly, we find the Examiner erred in rejecting claims 1, 9, 14. 19, 24, 28, 33, and 40 under 35 U.S.C. § 102(e) as being anticipated by Mullen. Since claims 5-8 depend from claim 1, claim 13 depends from claim 14, claim 18 depends from claim 14, claim 23 depends from claim 19, claims 29 and 30 depend from claim 28, claims 33 and 34 depend from claim 32, and claim 41 depends from claim 40, we additionally find the Examiner erred in rejecting claims 5-8, 13, 18, 23, 29, 30, 33, 34, and 41 under 35 U.S.C. § 102(e) as being anticipated by Mullen.

We also find Appellants have met the burden of showing the Examiner erred in finding Mullen teaches or suggests comparing the first description of the first condition with the second description of the second condition. Accordingly, we find the Examiner erred in rejecting claim 45 under 35 U.S.C. § 103(a) as being unpatentable over Mullen and Joory. Further, since claims 2-4 depend from claim 1, claims 10-12 depend from claim 9, claims 15-17 depend from claim 14, claims 20-22 depend from claim 19, claims 25-27 depend from claim 24, claim 31 depends from claim 28, claim 35 depends from claim 32, claims 42-44 depend from claim 40, we find the Examiner erred in rejecting claims 2-4, 10-12, 20-22, 15-17, 25-27, 31, 35, 42-44, 46, and 47 under 35 U.S.C. § 103(a) as being unpatentable over Mullen and Joory.

35 U.S.C. § 102(e): Claim 36

Appellants again assert their invention is not anticipated by Mullen (App. Br. 22). Specifically, Appellants contend Mullen fails to disclose a content server that includes a broadcast transmitter or memory (*id.*).

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The Examiner finds Mullen discloses a computer 2, which includes a network card 308 and memory 304 (Ans. 24, §(10)A.VII.). The Examiner finds the network card 308 serves as a broadcast transmitter and the computer as the content server with memory (*id.*).

Issue 2: Have Appellants met the burden of showing the Examiner erred in finding Mullen discloses a content server comprising a broadcast transmitter configured to provide media content to a client in response to a request from the client and memory?

35 U.S.C. § 103(a): Claim 37

Appellants argue neither Mullen nor Joory teaches or suggests value constraints, but instead teaches "attributes" (App. Br. 37).

The Examiner argues Joory teaches conditions (attributes) that are value constraints (Ans. 24, §B.I.).

Issue 3: Have Appellants met the burden of showing the Examiner erred in finding Joory teaches a value constraint?

ADDITIONAL FINDINGS OF FACT (FF)

Appellants' Specification

(3)   A remotely based application may be executed on a content server to provide content, such as a movie, web page, and so on (Spec. 4, [0006]).

(4)   A client may be configured as a computer capable of communication over a network, such as a mobile station, an entertainment appliance, a set-top box 108, television 110, and so forth (Spec. 9, [0022]). The client may also relate to a person and/or entity that operates the client and may be a logical client that includes a user and/or a machine (*id.*).

(5)   The field "letter grade" may have a value constraint that specifies that the letters "A", "B", "C", "D", and "F" for a value of the field (Spec. 5, [0007]).   Configuration settings may include a name of a field, a type of the field, and a description of a condition for the field (Spec. 8, [0021]). The condition may include value constraints, such as valid string patterns, scalar ranges for integer settings, and so on (*id.*).

Mullen Reference

(6)   The computer architecture 300 may include a processor 302 (e.g., a microprocessor), a memory 304 (e.g., a volatile memory device), and storage 306 (e.g., a non-volatile storage, such as magnetic disk drives, optical disk drives, a tape drive, etc.) (pg. 4, [0035]). Programs in the storage 306 are loaded into the memory 304 and executed by the processor 302 (*id.*). The architecture further includes a network card 308 to enable communication with a network (*id.*). An input device 310 is used to provide user input to the processor 302 (*id.*). An output device 312 is capable of rendering information transmitted from the processor 302, or other component.

Joory Reference

(7)   Joory teaches a method and system for accessing setup data from a source application or computer and using that data to supplant the setup data from a destination application or computer, while preserving the supplanted setup data for future use (Abstract).

(8)   In Microsoft Outlook, application setup data within information service settings may include attributes specified using menus, including (i) server name, (ii) mailbox, (iii) password, (iv) "when starting" settings, (v) additional mailboxes, (vi) "encrypt information" settings, (vii) logon

network security, (viii) offline folder file settings, (ix) mail account name,
(x) user name, (xi) organization, (xii) e-mail address, (xiii) reply address,
(xiv) incoming mail server, (xv) outgoing mail server, (xvi) account name,
(xvii) password, and (xviii) outgoing mail server settings - (account name,
password, etc.) (pg. 5, [0049]).

PRINCIPLES OF LAW

Claim Construction

"The Patent and Trademark Office (PTO) must consider all claim
limitations when determining patentability of an invention over the prior
art." *In re Lowry*, 32 F.3d 1579, 1582 (Fed. Cir. 1994) (citing *In re Gulack*,
703 F.2d 1381, 1385 (Fed. Cir. 1983)). "Claims must be read in view of the
specification, of which they are a part." *Markman v. Westview Instruments,
Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc) (citations omitted).

ANALYSIS

Issue 2

Mullen describes a computer architecture that includes a processor
and an output device capable of rendering information transmitted from the
processor or other component (FF 5). Since applications are installed on the
processor (FF 1 and Fig. 4) and delivered to another device over a network
(FF 6), we find Mullen describes a content server.

Content covers information supplied by an executed application (FF
3). Thus, since Mullen is a server (processor) that provides content
(information) to other devices, we find Mullen describes a content server.

Appellants recite, in claim 36, a broadcast transmitter that provides
media content to a single client in response to a request from that client.

Mullen discloses a network card that communicates with a network (FF 6).

Mullen further describes that an input device is used to provide user input to

the processor in a computer (*id.*). Therefore, we find Mullen discloses a

broadcast transmitter configured to provide media content to a client in

response to a request from the client.

Issue 3

We additionally find Joory teaches value constraints. Appellants

define value constraints to include valid string patterns, etc. (FF 5). Joory

teaches application set-up data that includes specified attributes that may be

selected, i.e., mailbox, password, etc. (FF 8). We find these attributes are

constrained to specific choices and thus, are value constraints. Therefore,

we find Joory teaches a value constraint.

CONCLUSION

Based on the findings of facts and analysis above, we conclude

Appellants have not met the burden of showing the Examiner erred in

finding Mullen discloses a content server comprising a broadcast transmitter

configured to provide media content to a client in response to a request from

the client and memory. Accordingly, we conclude Appellants have not met

the burden of showing the Examiner erred in rejecting claim 36 under 35

U.S.C. § 102(e) for anticipation by Mullen.

We further conclude Appellants have not met the burden of showing

the Examiner erred in concluding Joory teaches a value constraint.

Accordingly, we conclude Appellants have not met the burden of showing

the Examiner erred in rejecting claim 37 under 35 U.S.C. § 103(a) for

obviousness over Mullen and Joory.

Since Appellants argued claims 38 and 39 based on their dependency from claim 36, we find Appellants have not met the burden of showing the Examiner erred in rejecting claims 38 and 39 under 35 U.S.C. § 103(a) for obviousness over Mullen and Joory.

DECISION

The Examiner's rejection of claims 1, 5-9, 13-14, 18-19, 23-24, 28-30, 32-34, and 40-41 under 35 U.S.C. § 102(e) as being anticipated by Mullen is reversed.

The Examiner's rejection of claim 36 under 35 U.S.C. § 102(e) as being anticipated by Mullen is affirmed.

The Examiner's rejection of claims 2-4, 10-12, 15-17, 20-22, 25-27, 31, 35, 37-39, and 42-47 under 35 U.S.C. § 103(a) as being obvious over Mullen and Joory is reversed.

The Examiner's rejection of 37-39 under 35 U.S.C. § 103(a) as being obvious over Mullen and Joory is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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